

REMARKS

Claims 1-24 remain in the case. Reconsideration is requested in light of the following comments.

As will be seen hereinafter, previously submitted linking Claim 24 is deemed to be an allowable linking claim and thus we submit that it is proper to reconsider and withdraw the requirement for restriction. The Examiner is, therefore, requested to reconsider and withdraw the requirement for restriction.

The Examiner is thanked for calling attention in the 112 rejection of Claims 1-5, 13-18, and 20-24 to the inadvertent incorporation into the claims of the phrase used in the specification reading "at least two, and preferably three". We agree with the Examiner that such language is not suitable for use in the claims. Accordingly, the phrase has been amended in each of independent Claims 1, 7, 13 and 24 to read "two or three". Thus the 112 rejection has been rendered inapplicable. Clearly no change in scope has been effected by this amendment as it merely corrects an obvious informality.

Also by the above amendment Applicants have clarified the claims without changing their scope. In particular, while it was clearly understandable that the final clause in claims 1, 7, and 13 that the substituent being brominated is and always has been one having a benzylic carbon atom having 2 or 3 carbon atoms, these claims also refer to optional substituents which may be present on the aromatic ring-containing compound bearing one benzylic carbon atom. Because claims usually require antecedent basis for terms used therein, one might arrive at the obviously specious conclusion that the optional substituents on the ring are the ones being brominated. Thus to improve the form of the claim and thereby avoid any such subsequent specious interpretation of a patent claim, the words referring to bromination of "said ring-substituent" in Claims 1 and 13, and to dibromination of "said substituent" in Claim 7 have been replaced so that these claims now specify "said benzylic carbon atom". The same is true in Claim 24 where both such terms have been replaced.

Claims 1-6 and 13-24 have been rejected under 35 U.S.C. 103(a) on Elnagar, U.S. 6,103,926 ("Elnagar"). We respectfully point out that a *prima facie* case of obviousness under 35 U.S.C. 103(a) does not exist and cannot exist based on Elnagar. The rejection is based on the contention that:

Elnagar teaches a thermal benzylic bromination process for producing a benzyl bromide comprising, contacting bromine with a reaction mixture having an organic liquid phase comprising an aromatic ring-containing compound bearing one benzylic carbon atom at a temperature that is between 100°C to about 170°C.

[Emphasis added]

The Action cites Column 3, lines 16-67 through Column 4, lines 1-18 and Examples 1 and 2 of Elnagar for support of this contention. It is to be noted however that the substance of the above quoted contention does not appear in the cited portions of Elnagar, nor in fact, anywhere in Elnagar. What Elnagar actually teaches (Column 2, lines 14-27) is:

This invention makes it possible to carry out the thermal benzylic halogenation of primary or secondary alkylbenzoic acid esters using elemental halogen such as chlorine or, preferably, bromine, to produce the corresponding benzylically brominated ester. The desired product can be produced in good yield in a one-step synthesis. Ester cleavage during halogenation is minimized. Moreover, the thermal halogenation process is insensitive to impurities often present in starting toluate esters such as p-toluic acid or its salts. And the only appreciable co-product formed is hydrogen halide, materials which can readily be recovered, and converted to or used in the synthesis of other products. Thus problems associated with waste product formation and disposal are minimized.

[Emphasis added]

It can be seen therefore that the Action has modified the teachings of Elnagar to describe a generic class of reactant materials, viz., a benzyl bromide, which is not taught by Elnagar. Instead Elnagar actually describes primary or secondary alkylbenzoic acid esters as reactants. Moreover, the Action has modified the teachings of Elnagar to describe formation of a generic class of products which is not taught by Elnagar, viz., an aromatic ring-containing compound bearing one benzylic carbon atom, as product formed by the process. Instead Elnagar actually describes a benzylically brominated ester as product formed by the process. Such modifications of the Elnagar teachings are not supported by Elnagar nor is any explanation provided in the Action to support such an unwarranted modification of the Elnagar teachings. As pointed out in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Here no prior art suggests the desirability of conducting any benzylic reaction to effect benzylic bromination other than carrying out a thermal benzylic halogenation of primary or secondary alkylbenzoic acid esters using elemental halogen such as chlorine or, preferably, bromine, to produce the corresponding benzylically brominated ester. The subject matter of the present claims is beyond the teachings of Elnagar.

Furthermore, the presently-claimed subject matter is not obvious in view of Elnagar. At best, use of Elnagar as a reference basically constitutes an "obvious to try" basis for the rejection. However, it is well-settled that "obvious to try" is not a proper basis for a 103 rejection. See for example *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967), *In re Tomlinson*, 363 F.2d 928, 150 USPQ 623 (CCPA 1966), *In re Henderson*, 348 F.2d 550, 146 USPQ 372 (CCPA 1965), *In re Heullmantel*, 324 F.2d 998, 139 USPQ 496 (CCPA 1963).

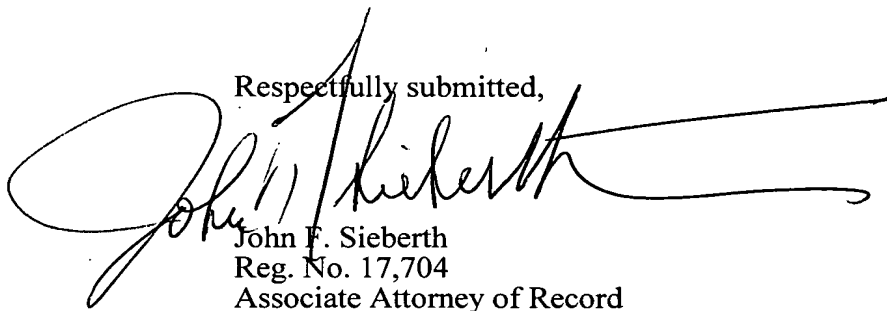
For the record, the statement in the Action at the middle of page 5 that at Column 3, lines 44-50 Elnagar teaches generally that substituents on the aromatic ring-containing compounds which are devoid of non-aromatic unsaturation, are not susceptible to halogenation, is noted. What Elnagar is discussing there is substituents, R, which are in the ester group and thus are not directly bonded to the ring. Thus no relevance is seen for this portion of the Elnagar patent.

For a 103 rejection to be viable, a *prima facie* case of obviousness must be established by the Examiner. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Since, as noted above a *prima facie* case has not been established here, the rejection based on Elnagar is inapplicable and untenable. Therefore reconsideration and withdrawal of the rejection are requested.

For the reasons given above it is believed that the case is in condition for allowance. Notification to this effect is solicited. If, however, any matters remain in requiring further consideration, the Examiner is respectfully requested to telephone the undersigned so that such matters can be discussed, and if possible, promptly resolved.

Please continue to address all correspondence in this Application to Mr. Edgar E. Spielman, Jr. at the address of record.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read "John F. Sieberth".

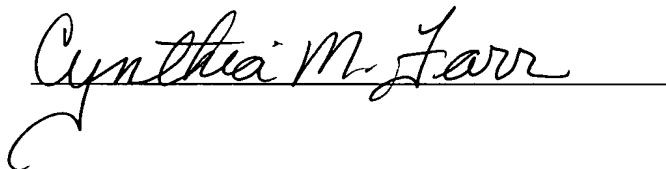
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01-20-04
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A handwritten signature in black ink, appearing to read "Cynthia M. Farr".